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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,612	12/09/2003	Jeffrey M. Dils	10710-623(PTG 0633 PUS2)	4771
757	7590	11/13/2006	EXAMINER	
BRINKS HOFER GILSON & LIONE P.O. BOX 10395 CHICAGO, IL 60610			NGUYEN, PHONG H	
			ART UNIT	PAPER NUMBER
			3724	

DATE MAILED: 11/13/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/731,612	Applicant(s) <sup>NC</sup> DILS ET AL.	
	Examiner Phong H. Nguyen	Art Unit 3724	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 12 April 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 and 22-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 22-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                                        |                                                                                         |
|------------------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                            | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____                                                |

## DETAILED ACTION

### *Claim Rejections - 35 USC § 102*

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1 and 4 are rejected under 35 U.S.C. 102(e) as being anticipated by Bean et al. (D441,771 S), hereinafter Bean.

Bean teaches a miter saw comprising a base, an arm assembly having a handle. The handle comprises a gripping portion and a palm pad portion. See Figs. 1-7. The following paragraphs are the Examiner's interpretations of Bean's handle:

The distant (a1) in Fig. 6 is 120 mm. The distant (a2) of a real miter saw is about 559mm, which is 22 inches. Therefore, the scale of Fig. 6 with respect to the real miter saw is  $a1/a2 = 120/559 = 1/5$ .

Having the width of the handle being  $d1 = 10$  mm and the scale being  $1/5$ , the distant (d2) of a real miter is  $10 \text{ mm} \times 5 = 50 \text{ mm}$ , which is 2 inches.

The length of a palm of an adult person is 3-4 inches. The heel portion as defined in Fig. 3 of the Applicant's disclosure is  $3/4$  the length of the palm measured from the base of the fingers to the wrist. Therefore, the heel portion has a length about 3

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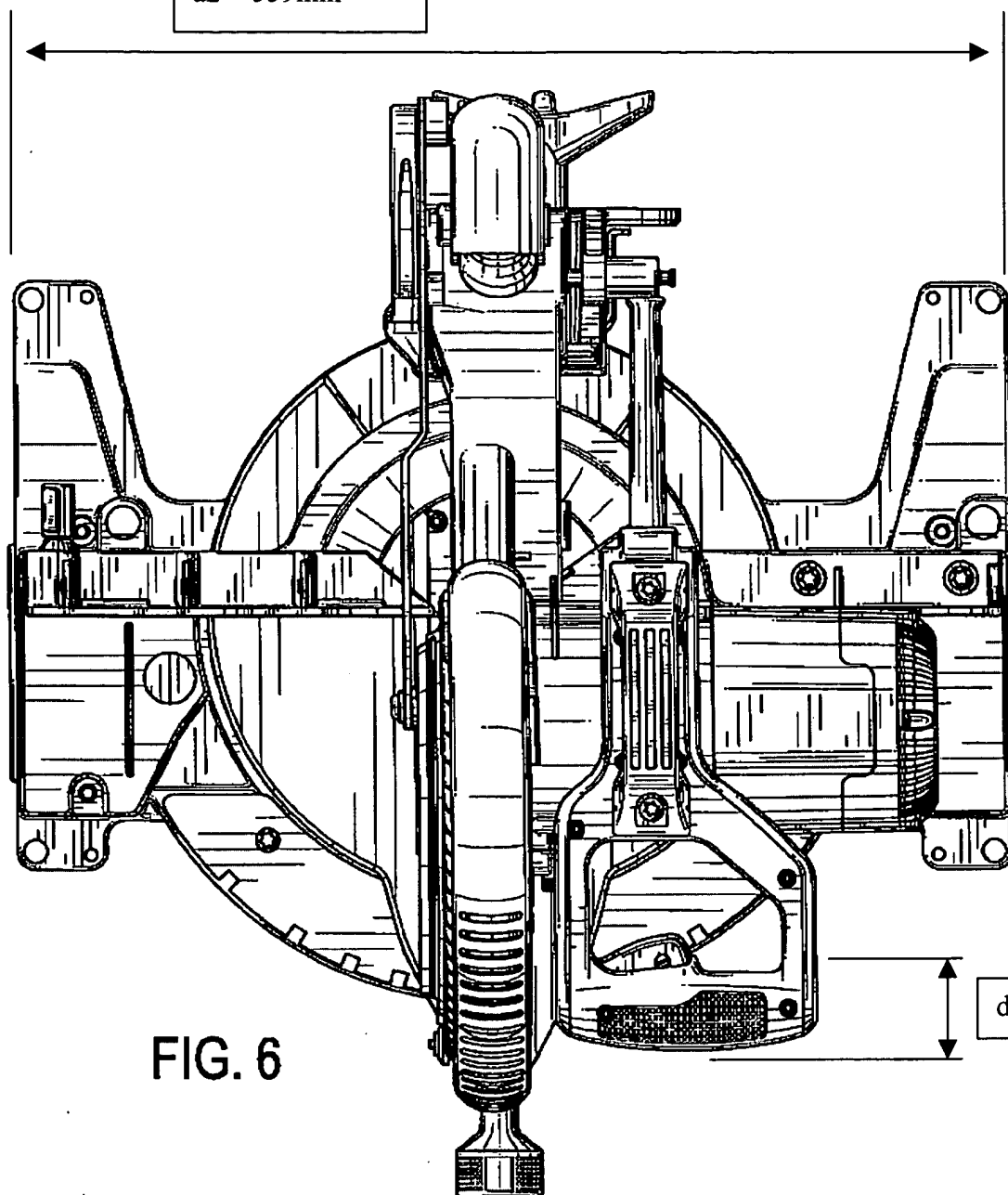
inches. Since the Bean's handle extends into the palm's area defined as the heel portion,

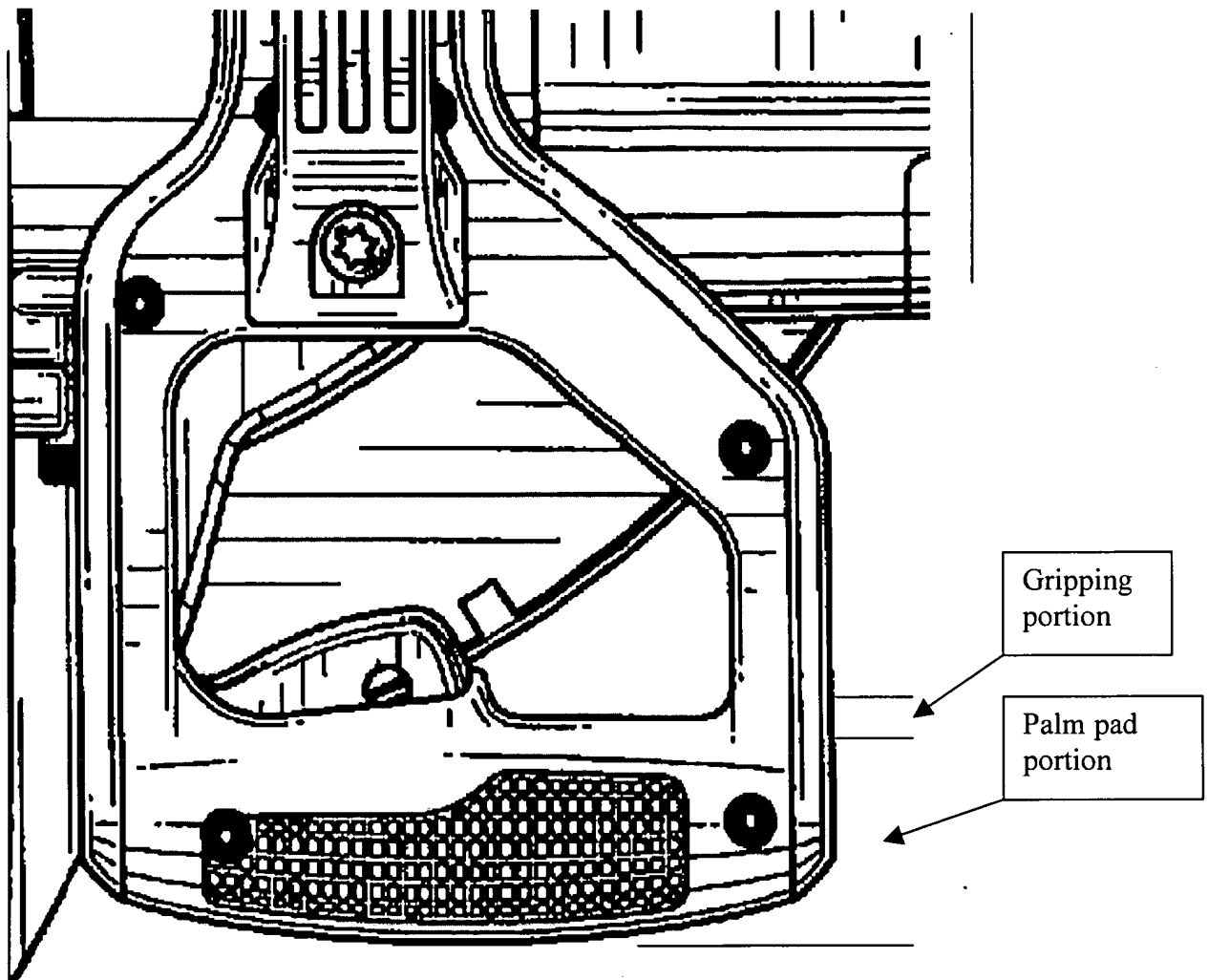
Bean meets the limitation (c).

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$a1 = 120\text{mm}$

$a2 = 559\text{mm}$





*Claim Rejections - 35 USC § 103*

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bean in view of Svetlik et al. (5,969,312), hereinafter Svetlik.

Bean teaches the invention substantially as claimed except for a lock-out switch. Svetlik teaches a lock-out switch. See Fig. 2. Therefore, it would have been obvious to one skilled in the art to incorporate the lock-out switch as taught by Svetlik to the miter saw of Bean for safely operating the miter saw.

5. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Bean in view of Bidanset (4,912,848).

Bean teaches the invention substantially as claimed except for an elastomeric cover. Bidanset teaches providing an elastomeric cover 29 on the handle of a powered saw. See Fig. 3. Therefore, it would have been obvious to one skilled in the art to provide an elastomeric cover as taught by Bidanset on the handle of Bean for damping the vibration of the handle during a cutting operation.

6. Claims 1, 4-9, 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brunson et al. (5,802,943), hereinafter Brunson, in view of Bean and Pause (1,119,787).

Regarding claims 1, 4-6, 9, 22 and 23, Brunson teaches a miter saw comprising a base and an arm assembly having a fixed end attached to the base and a free distal end forming a handle 24. See Figs. 3 and 4.

Brunson fails to teach the size of a palm pad portion of the handle and the handle being connected to a central region of the arm assembly via a rotatable joint.

Bean teaches a specific size of the palm pad portion as presented in paragraph 2. Therefore, it would have been obvious to one skilled in the art to incorporate the dimension of the palm pad portion in Bean into the handle of Brunson so that users can comfortably operate the saw.

Pause teaches connecting a handle 12 to a central region via a rotatable joint (15, 16, 17, 18 and 20). See Figs. 1 and 2. Therefore, it would have been obvious to one skilled in the art to incorporate the rotatable joint as taught by Pause to the miter saw of Brunson to increase the adjustability of the handle in the Brunson's saw.

As the rotatable joint is incorporated into the Brunson's saw, the handle in Brunson's saw can be adjustable between at least 0-30 degrees.

Regarding claims 7 and 8, to the degree the Applicant would argue that Bean does not teach a specific dimension of the handle, providing a specific dimension for the handle so that the saw can be marketed to a desired market such as Europe or Asia is routine skill in the art. For example, miter saws for sale in Europe should have bigger handles than ones for sale in Asia since Europeans have bigger hands than Asians do. Therefore, it would have been obvious to one skilled in the art to make a handle having a width of 3"-4.5" and a thickness of 1.5"-2.5" since such practice is routine skill in the art.

7. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Brunson, in view of Bean and Pause as applied to claims above, and further in view of Kaley (2,806,491).

The modified device of Brunson teaches the invention substantially as claimed except for an indicia for indicating angular rotations of the handle. Kaley teaches an



indicia 18 for indicating angular rotations of a handle 36. See Fig. 1. Therefore, it would have been obvious to one skilled in the art to provide an indicia as taught by Kaley to the modified saw assembly of Brunson for indicating angular rotations of the handle.

### ***Response to Arguments***

8. Applicant's arguments filed on 08/30/2006 have been fully considered but they are not persuasive.

Regarding the Applicant's argument with respect to Bean, the last paragraph of MPEP 1502, Definition of a Design, states: "Design is inseparable from the article to which it is applied and cannot exist alone merely as a scheme of surface ornamentation. It must be a definite, preconceived thing, capable of reproduction and not merely the chance result of a method." The paragraph implies that there is a ratio between parts in the drawings and parts in an actual model. Therefore, it would have been obvious to one skilled in the art to compare dimensions of an actual model and a drawing model to derive inexplicitly stated dimensions.

The Applicant argues that there is no explicit teaching to combine the references together. This argument is not persuasive. The teachings need not to be expressly suggested in the references. The teaching could be experience of one of ordinary skill in the art.

### ***Conclusion***

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phong H. Nguyen whose telephone number is 571-272-4510. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Boyer Ashley can be reached on 571-272-4502. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business

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Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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October 27, 2006

*✓*

**Timothy V. Eley**  
**Primary Examiner**